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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,855	07/25/2003	Lauro Alvicio Volkart	024733-00010	9804
4372	7590	08/23/2005	EXAMINER	
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,855

Applicant(s)

VOLKART, LAURO ALVICIO

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The Substitute Specification filed June 8, 2005 has been accepted and entered. Also, the revised Abstract filed June 8, 2005 ha also been received and entered into the application.

Claim Rejections - 35 USC § 112

2. Claims 9 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9 contains the materials fiberglass, graphite and carbon, which were not disclosed in the description as originally filed. Claim 13 contains the materials nylon foam, pressurized air and pressurized gas, which were not disclosed in the description as originally filed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4, 6-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown 4,782,603. Brown '603 discloses all the limitations of the claims including the following:
at least one absorber set 30 40 disposed in a sole of the sports shoe; the at least one absorber set

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having a plurality of tubular elements 60, 50 arranged parallel to one another and positioned transversely in relation to the longitudinal axis of the sports shoe (see Figure 2); the plurality of tubular elements being formed of at least one resilient material (polyurethane); a pair of laterally disposed walls (polyurethane) on opposite side ends of the plurality of tubular elements, enclosing the tubular elements in the absorber set (tubes located inside molten polyurethane then PU is cooled); the plurality of tubular elements in an unloaded state has an elliptical shape in cross-section (a circle is a special ellipse and therefore, the circular elements of Brown have an “elliptical” shape); at least one absorber set comprises a first absorber set disposed in a heel region of the sports shoe 30; a second absorber 50 set disposed in a front region of the sports shoe; the at least one absorber set is disposed along the entire length of the sports shoe (see Figures 1 and 2); the plurality of tubular elements have differing sizes, wall thicknesses and flexibilities (see differences between the tubes 60 and 50 of the absorber sets in Figures 1 and 2); the plurality of tubular elements have the same size, wall thicknesses and flexibility (see col. 1, lines 49-53, tubes of each set are the same size as other tubes of the same set); the at least one resilient material is a flexible polymer (polyurethane); the plurality of tubular elements are arranged at irregular intervals (between 30 and 40); the plurality of tubular elements are arranged at regular intervals (within their own sets); the interior of the plurality of tubular elements is filed with compressed air (when the user’s foot applies pressure).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being obvious over Brown 4,782,603 as applied above. Brown '603 discloses absorbers that are located throughout the shoe sole. Therefore, splitting this up into different regions of the sole, i.e. the forefoot area, the heel area and the arch area would be well within the skill of one of ordinary skill in the art to allow the flexibility of the shoe sole as well as to allow for variability in the cushioning of the user's foot. With respect to claim 10, the material of Brown '603 uses a plastic (polyurethane) and nitril butadiene, which acts like a resin, therefore anticipating this limitation in the claim. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the tubular elements of Brown '603 out of a plastic as taught by Brown '603 mixed with resin (to hold the plastics together) to help in holding the tubular elements together during use.

Response to Arguments

7. Applicant's arguments filed with respect to the Brown reference have been fully considered but they are not persuasive. Applicant argues that Brown does not disclose the tubular elements having an elliptical shape in cross-section but has a circular shape in cross-section. Since a circle is a special ellipse whose foci are located at the same position, the circular cross-section of the Brown tubular elements thereby meets this limitation in the claims.

Conclusion

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1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

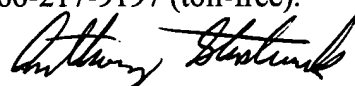
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

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